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LOUISVILLE, KY 40202				
EXAMINER				
NGUYEN, PHU HOANG				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,516

**Applicant(s)**

WOODS, DEBRA DEMETER

**Examiner**

PHU H. NGUYEN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 6/9/2005

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of group I, claims 1-29 in the reply filed on 9/14/2009 is acknowledged.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055).

Regarding claims 1-6 and 10, Noe discloses a smoking article having sidestream smoke flavor, said smoking article comprising a rod of smoking material enwrapped in wrapper means, said wrapper means comprising two layers of wrapper material, and encapsulated flavour material being held between an inner and an outer layer of said wrapper means. However, Noe discloses controlling the burn off behavior through the outer wrapper alone by setting the porosity ratio of the inner wrapper to be higher than that of the outer wrapper (column 3, line 63 to column 4, line 33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to control the burn off behavior through the inner wrapper alone by invert the porosity ratio so that the outer wrapper has a higher porosity than that of the inner wrapper.

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Furthermore, the inversion of porosity ratio would switch the inner wrapper to the outer wrapper and vice versa therefore one can use an available wrapper material with permeability of at least 10000 C.U. (column 4, lines 4-10).

Regarding claims 7-9, Noe discloses visible wrapper with air permeability of 10 to 60 CORESTA overlapping with the claimed ranges (column 3, lines 62-66), therefore it would have been obvious to one of ordinary skill in the art to pick the claimed range.

Regarding claim 10, Noe discloses the encapsulated flavor material is in capsule form (column 2, lines 20-35 and column 4, lines 40-46).

Regarding claim 11, Noe does not expressly disclose the method of making the encapsulated flavor material, however in a product by process claim, the method of making does not distinguish the product from that of the prior art.

Regarding claims 13-14, Noe discloses the encapsulated material comprises vanillin (Example 1, column 5).

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S. Patent No. 5494055) as applied to claim 14 above and further in view of Griffiths et al. (U.S. Patent No. 6489103). Although Noe discloses the flavor material comprises microcapsules but does expressly disclose an encapsulation technique in generating these capsules. Griffiths discloses microcapsules can be generated by interfacial polymerization and interfacial complexation (column 8, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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make the capsules of Noe from an interfacial complexation technique as taught by Griffiths.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) as applied to claim 14 above and further in view of Microgelencapsulation: methods and industrial applications by Simon Benita Griffiths et al. (1996). Although Noe discloses the flavor material comprises microcapsules but does expressly disclose an encapsulation technique in generating these capsules. Whately discloses microcapsules can be generated by interfacial polymerization and interfacial complexation with sodium chloride (Whateley T. L., page 366-367). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the capsules of Noe from an interfacial complexation technique as taught by Whateley.

Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) in view of Boden (U.S Patent No. 4471789).

Regarding claim 14, Noe discloses the encapsulated flavor material comprises vanillin but does not expressly disclose gamma undecalactone. Boden discloses gamma undecalactone as a flavor material for tobacco (column 32, lines 45-60); therefore it would have been obvious to one of ordinary skill in the art to use a well known flavor material for tobacco as taught by Boden as a flavor material in the smoking article of Noe.

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Regarding claim 15, in a product by process claim, the method of making does not distinguish the product from that of the prior arts.

Regarding claims 16-19, since the smoking article of Noe and Boden would have the flavor material comprises gamma undecalactone and the structure as discussed above for claims 1 and 14, one of ordinary skill in the art at the time the invention was made would expect the smoking article to have the sidestream to mainstream flavor delivery ratio overlapping with the claimed ranges and it would have been obvious to one of ordinary skill in the art to pick the claimed ranges.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) in view of Boden (U.S Patent No. 4471789) as applied to claim 14 above and further in view of Griffiths et al. (U.S Patent No. 6489103). Although Noe and Boden discloses the flavor material comprises microcapsules but does expressly disclose an encapsulation technique in generating these capsules. Griffiths discloses microcapsules can be generated by interfacial polymerization and interfacial complexation (column 8, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the capsules of Noe from an interfacial complexation technique as taught by Griffiths.

Claims 14,20-24 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) in view of Yoshida (U.S Patent No. 4431680).

Regarding claim 14, Noe discloses the encapsulated flavor material comprises vanillin but does not expressly disclose peppermint oil nor spearmint oil. Yoshida discloses tobacco flavor materials such as peppermint oil and spearmint oil for tobacco (column 27, lines 55-68); therefore it would have been obvious to one of ordinary skill in the art to use a well known flavor material for tobacco as taught by Boden as a flavor material in the smoking article of Noe.

Regarding claims 20 and 24, in a product by process claim, the method of making does not distinguish the product from that of the prior arts.

Regarding claims 21-23 and 25-28, since the smoking article of Noe and Yoshida would have the flavor material comprises gamma undecalactone and the structure as discussed above for claims 1 and 14, one of ordinary skill in the art at the time the invention was made would expect the smoking article to have the sidestream to mainstream flavor delivery ratio overlapping with the claimed ranges and it would have been obvious to one of ordinary skill in the art to pick the claimed ranges.

Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) in view of Yoshida (U.S Patent No. 4431680) as applied for claim 14 above and further in view of Griffiths et al. (U.S Patent No. 6489103). Although Noe and Yoshida discloses the flavor material comprises microcapsules but does expressly disclose an encapsulation technique in generating these capsules. Griffiths discloses microcapsules can be generated by interfacial polymerization and interfacial complexation (column 8, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to make the capsules of Noe from an interfacial complexation technique as taught by Griffiths.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe et al. (U.S Patent No. 5494055) in view of Owens (U.S Patent No. 4082098). Noe does not expressly disclose the smoking article is ventilated. Owens discloses a ventilated cigarette uniquely designed to introduce volatile flavoring agents into the mainstream smoke of cigarette with improved delivery rate and longer shelf life for the flavoring agent. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ventilate the smoking article to achieve longer shelf life for the flavoring agent.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 11/27/2009

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791